

REMARKS

The Office Action dated January 5, 2004, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claims 7, 15, 23, 31, 39, 47, 50, 53-56, and 59 have been amended. Claims 62-71 have been added. Support for the amendments to the claims can be found on page 16 lines 19-27, page 17 lines 4-9 and page 18 lines 22 to page 19 line 5 of the specification. No new matter has been added. Claims 7-71 are pending and respectfully submitted for consideration.

Claims 7-46 were rejected under 35 U.S.C. § 102(e) as being anticipated by Aoki et al. (U.S. Patent No. 6,243,220B1, "Aoki"). The Applicants submit that claims 7-46 recite subject matter that is neither disclosed nor suggested by Aoki.

With respect to claims 7, 15, 23, 31 and 39 from which claims 8 through 46 depend, the Applicants respectfully submit that Aoki fails to disclose each and every feature of the claimed invention. Claims 7, 15, 23, 31 and 39 recite a "disc-shaped recording medium comprising an object data recording zone . . . and a management data recording zone located in a different position from the object data recording zone in a direction of a diameter of the recording medium". In contrast, Aoki discloses a method of recording on a magnetic tape. In Aoki, the audio signal area for recording object data and the audio subcode area for recording control information are adjacent to each other, and form one block. Such blocks in Aoki are recorded in a line on the magnetic tape. As such, the audio signal area and the audio signal subcode area in Aoki are not in different zones from each other. As such Aoki does not disclose or suggest disc-

shaped recording medium comprising an object data recording zone . . . and a management data recording zone located in a different position from the object data recording in a direction of a diameter of the recording medium as recited in the claims.

Claims 7, 15, 23, 31 and 39 also recite control information including application information. In contrast, Aoki fails to disclose this feature of the invention. Although the Office Action took the position that Aoki discloses control information including application information, the Office Action has not identified where the reference discloses this feature. As such, Aoki fails to disclose each and every feature of the invention as recited in claims 7, 15, 23, 31 and 39.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim. . . the identical invention, specifically, [t]he identical invention must be shown in as complete detail as contained in the claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). The Applicants respectfully submit that Aoki does not disclose or suggest an object data recording zone and a management data recording zone in a disc-shaped recording medium as arranged in the claim. Accordingly, Aoki does not anticipate claims 7-46, or are claims 7-46, obvious in view of Aoki.

Claims 47-61 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Aoki in view of Oguru (U.S. Patent No. 6,097,558). Aoki was cited for disclosing a first recording area, and a second recording area in a different position from the first recording area. The Office Action acknowledges that Aoki does not disclose control information, including a mixed mode flag. Oguru was cited for curing the deficiencies in Aoki. The Applicants respectfully submit that claims 47-61 recite subject matter that is neither disclosed nor suggested by the combination of Aoki and Oguru. Claims 48 and 49 depend from claim 47, claims 51 and 52 depend from claim 50, claims 54 and 55 depend from claim 53, claim 57 and 58 depend from claim 56, and claims 60 and 61 depend from claim 59.

As a preliminary matter, the Applicants submit the combination of Aoki and Oguru fails to disclose or suggest the features of the invention as recited in amended claims 47-61. Claims 47, 50, 53, 56, and 59 recite disc-shaped recording medium comprising an object data recording zone . . . and a management data recording zone located in a different position from the object data recording zone in a direction of a diameter of the recording medium." As discussed above, Aoki fails to disclose or suggest a disc-shaped recording medium and an object data recording zone and management data recording zone located in different positions feature. Oguru also fails to disclose this claimed feature of the invention. As such, Oguru fails to cure the deficiencies in Aoki with respect to claims 47, 50, 53, 56, and 59.

In addition, as acknowledged in the Office Action, Aoki fails to disclose control information including a mixed mode flag as recite in claims 47, 50, 53, 56, and 59. Oguru also fails to disclose control information including a mixed mode flag. Oguru

discloses that when the MIX is "1", it represents that the composite audio data is not present. According to Oguru, the composite audio data is data from different channels. Data from different channels are not comparable to the mixed stereophonic recording mode and mixed multiplexed recording mode. Therefore, the functions of the MIX (1 bit) in Oguru are different from the mixed mode flag disclosed in the present invention and recited in the claims. Accordingly, Oguru fails to cure the deficiencies in Aoki with respect to claims 47, 50, 53, 56, and 59.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in

the applied references to evidence the desirability of these advantages in the disclosed structure.

In view of the above, the Applicants respectfully submit that the combination of Aoki and Oguru does not support a *prima facie* case of obviousness for purposes of a rejection of claims 47-61 under 35 U.S.C. §103.

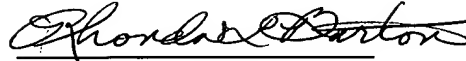
Claims 8-14 and 62 depend from claim 7, claims 16-22 and 63 depend from claim 15, claims 24-30 and 64 depend from claim 23, claims 32-38 and 65 depend from claim 31, claims 40-46 and 66 depend from claim 39, claims 48, 49 and 67 depend from claim 47, claims 51, 52 and 68 depend from claim 50, claims 54, 55 and 69 depend from claim 53, claims 57, 58 and 70 depend from claim 56, and claims 60, 61 and 71 depend from claim 59. The Applicants respectfully submit that these dependent claims are allowable at least because of their dependency from allowable base claims 7, 15, 23, 31, 39, 47, 50, 53, 56, and 59. Accordingly, the Applicants respectfully request allowance of claims 7-71 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt.**

No. 107156-09071.

Respectfully submitted,



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Enclosures: Petition for Extension of Time (one month)
Extra Claims Transmittal